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EXAMINER	
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ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/680,505	SHIOBARA, TATSUYA	
	Examiner	Art Unit	
	NEAL R. SEREBOFF	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8-13,16 and 17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-13,16 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Regarding the amendment dated 12/26/2008, the following has occurred: Claims 1, 8 – 13, 16 and 17 have been amended.

2. Claims 6, 7, 14 and 15 were previously canceled. Claims 1-5, 8-13, 16 and 17 are pending.

Notice to Applicant

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

4. Claims 10 and 11 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a particular machine (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (10 and 11) are not tied to a particular apparatus nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

5. ***Claims 1-5, 8-13, 16 and 17*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al., U.S. Patent Number 6,047,259 in view of Oon, U.S. Patent Number 7,321,861.

6. As per claim 1, Campbell teaches a system for use in generating a diagnosis report, comprising:

- A processor (figure 1, #120, #121);
- An observation term selection result obtaining unit obtaining a selection result from a plurality of observation terms about an observation term corresponding to an observation on an examination result (figure 5);
- A supplementary information result obtaining unit obtaining a selection result of supplementary information corresponding to the observation from a plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6);
- An observation text generation unit generating observation text representing the observation term relating to the selection result obtained by the observation term selection result obtaining unit and the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit (figure 6 and column 15, lines 5 - 52);
- An observation display unit displaying the observation text (figure 1, monitor and screens found on figure 3 – 6);
- A treatment information input request notification unit transmitting a notification of a request to input treatment information about the treatment in response to the observation text when the observation text is displayed on said observation display unit (figure 10, recommended therapy and column 17, lines 46 – 67);

- A treatment information obtaining unit obtaining the treatment information input in response to the notification (column 17, lines 46 - 67 and column 18, lines 7 - 11);
- A storage unit storing observation information indicating the observation associated with the treatment information (column 3, lines 34 – 63); and

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining unit (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining unit (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

7. As per claim 2, Campbell in view of Oon teaches the system of claim 1 as described above. Campbell further teaches the system wherein said observation information is formed by the observation terms relating to the selection result obtained by the observation term selection result obtaining unit and the supplementary information relating to the selection result about the supplementary information obtained by the supplementary information result obtaining unit (paragraph 212–216 where the diagnosis is generated).

8. As per claim 3, Campbell in view of Oon teaches the system of claim 1 as described above. Campbell further teaches the system comprising an observation term list display unit displaying a list of a plurality of observation terms (figure 6 where the plurality of terms are included within the temperature history and Figure 7 where there is a list of lesions).

9. As per claim 4, Campbell in view of Oon teaches the system of claim 1 as described above. Campbell further teaches the system comprising a supplementary information list display unit displaying a list of supplementary information associated with the observation term (figure 6 is supplemental to figure 5), wherein said supplementary information result obtaining unit can obtain a selection result from the list of the supplementary information (Figure 6 where the lists

include kidneys, spleen, bladder, prostate and further column 15, lines 5 – 52 where different supplemental screens are possible).

10. As per claim 5, Campbell in view of Oon teaches the system of claim 4 as described above. Campbell further teaches the system wherein said supplementary information list display unit displays a list of the supplementary information based on the selection result of the observation term obtained by said observation term selection result obtaining unit (figure 6, where the screen shows information regarding the abdominal example from figure 5).

11. As per claim 8, Campbell in view of Oon teaches the system of claim 1 as described above. Campbell further teaches the system comprising an observation display format switch unit switching between a display of the observation text on said observation display unit and a display of a list of observation terms relating to the selection result obtained by the observation term selection result obtaining unit and supplementary information relating to the selection result obtained by the supplementary information result obtaining unit (column 15, lines 5 – 20 where the software triggers additional screens when required).

12. As per claim 9, Campbell teaches a system for use in generating a diagnosis report, comprising:

- A processor (figure 1, #120, #121);
- An observation term selection result obtaining unit obtaining a selection result from a plurality of observation terms about an observation term corresponding to observation on an examination result (figure 5);
- A supplementary information result obtaining unit obtaining the selection result of supplementary information corresponding to the observation from plural pieces of

supplementary information associated with the observation term relating to the selection result (figure 6);

- An observation text generation unit generating observation text representing the observation term relating to the selection result obtained by the observation term selection result obtaining unit and the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit (figure 6 and column 15, lines 5 - 52);
- An observation information storage unit storing observation information (column 3, lines 34 – 63) which is formed by the observation term relating to the selection result obtained by the observation term selection result obtaining unit and the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit, and indicates the observation (Column 8, lines 1 – 26 as an example);

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining unit (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result

obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining unit (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

13. As per claim 10, Campbell teaches a computer-implemented method for generating a diagnosis report, comprising:

- Obtaining a selection result from a plurality of observation terms about an observation term corresponding to an observation on an examination result (figure 5 and column 2, lines 54 – 56);
- Obtaining a selection result of supplementary information corresponding to the observation from a plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6 and column 2, lines 57 – 60);

- Generating observation text representing the observation term relating to the obtained selection result and the supplementary information relating to the obtained selection result (figure 6 and column 15, lines 5 - 52);
- Displaying the generated observation text on a display device (figure 1, monitor and screens found on figure 3 – 6);
- Transmitting a notification of a request to input treatment information about the treatment in response to a display of the observation text (figure 10, recommended therapy and column 17, lines 46 – 67);
- Obtaining the treatment information input in response to the notification (column 17, lines 46 - 67 and column 18, lines 7 - 11)
- Storing observation information indicating the observation associated with the treatment information (column 3, lines 34 – 63);

Campbell does not explicitly teach the system comprising:

- Wherein the observation text is generated by arranging a word and phrase that have been, in advance, associated with the supplementary information relating to the obtained selection result before and after the observation term relating to the obtained selection result (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text is generated by arranging a word and phrase that have been, in advance, associated with the supplementary information relating to the obtained selection result before and after the observation term relating to the obtained selection

result (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

14. As per claim 11, Campbell teaches a computer-implemented method for generating a diagnosis report, comprising:

- Obtaining a selection result from a plurality of observation terms about an observation term corresponding to observation on an examination result (figure 5 and column 2, lines 54 – 56);
- Obtaining the selection result of supplementary information corresponding to the observation from plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6 and column 2, lines 57 – 60);

- Generating observation text representing the observation term relating to the obtained selection result and the supplementary information relating to the obtained selection result (figure 6 and column 15, lines 5 - 52);
- Storing observation information (column 3, lines 34 – 63) which is formed by the observation term relating to the obtained selection result and the supplementary information relating to the obtained selection result, and indicates the observation (Column 8, lines 1 – 26 as an example); and

Campbell does not explicitly teach the system comprising:

- Wherein the observation text is generated by arranging a word and phrase that have been, in advance, associated with the supplementary information relating to the obtained selection result before and after the observation term relating to the obtained selection result (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text is generated by arranging a word and phrase that have been, in advance, associated with the supplementary information relating to the obtained selection result before and after the observation term relating to the obtained selection result (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

15. As per claim 12, Campbell teaches a computer storage device readable by a computer, having a program of instructions executable by the computer to direct a computer to generate a diagnosis report, and is executed by the computer to perform the process comprising:

- An observation term selection result obtaining process of obtaining a selection result from a plurality of observation terms about an observation term corresponding to an observation on an examination result (figure 5);
- A supplementary information result obtaining process of obtain in a selection result of supplementary information corresponding to the observation from a plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6);
- An observation text generation process of generating observation text representing the observation term relating to the selection result obtained by the observation term selection result obtaining process and the supplementary information relating to the selection result obtained by the supplementary information result obtaining process (figure 6 and column 15, lines 5 - 52);

- An observation displaying process of allowing a display device to display the observation text (figure 1, monitor and screens found on figure 3 – 6);
- A treatment information input request notifying process of transmitting a notification of a request to input treatment information about the treatment in response to a display of the observation text (figure 10, recommended therapy and column 17, lines 46 – 67);
- A treatment information obtaining process of obtaining the treatment information input in response to the notification (column 17, lines 46 - 67 and column 18, lines 7 - 11);
- A storing process of storing observation information indicating the observations associated with the treatment information (column 3, lines 34 – 63); and

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining process (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term

selection result obtaining proces (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

16. As per claim 13, Campbell teaches a computer storage device readable by a computer, having a program of instructions executable by the computer to generate a diagnosis report, and is executed by the computer to perform the process comprising:

- An observation term selection result obtaining process of obtaining a selection result from a plurality of observation terms about an observation term corresponding to observation on an examination result (figure 5);
- A supplementary information result obtaining process of obtaining the selection result of supplementary information corresponding to the observation from plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6);

- An observation text generation process of generating observation text representing the observation term relating to the selection result obtained by the observation term selection result obtaining process and the supplementary information relating to the selection result obtained by the supplementary information result obtaining process (figure 6 and column 15, lines 5 - 52);
- An observation information storage process of storing observation information (column 3, lines 34 – 63) which is formed by the observation term relating to the selection result obtained by the observation term selection result obtaining process and the supplementary information relating to the selection result obtained by the supplementary information result obtaining process, and indicates the observation (Column 8, lines 1 – 26 as an example); and
- Wherein the observation text generation process generates the observation text that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining process before and after the observation term relating to the obtained selection result obtained by the observation term selection result obtaining process (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the

observation term relating to the selection result obtained by the observation term selection result obtaining process (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining process (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

17. As per claim 16, Campbell teaches a system for use in generating a diagnosis report, comprising:

- A processor (figure 1, #120, #121);
- Observation term selection result obtaining means for obtaining a selection result from a plurality of observation terms about an observation term corresponding to an observation on an examination result (figure 5 and column 2, lines 54 – 56);
- Supplementary information result obtaining means for obtaining a selection result of supplementary information corresponding to the observation from a plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6 and column 2, lines 57 – 60);
- Observation text generation means for generating observation text representing the observation term relating to the selection result obtained by the observation term selection result obtaining means and the supplementary information relating to the selection result obtained by the supplementary information result obtaining means (figure 6 and column 15, lines 5 - 52);
- Observation display means for displaying the observation text (figure 1, monitor and screens found on figure 3 – 6);
- Treatment information input request notification means for transmitting a notification of a request to input treatment information about the treatment in response to the observation text when the observation text is displayed on said observation display means (figure 10, recommended therapy and column 17, lines 46 – 67);
- Treatment information obtaining means for obtaining the treatment information input in response to the notification (column 17, lines 46 - 67 and column 18, lines 7 - 11);

- Storage means for storing observation information indicating the observation associated with the treatment information (column 3, lines 34 – 63); and

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining means (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining means (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

Where the observation text generation means, the observation display means, the treatment information obtaining means, the storage means are all a computer, with display and databases (column 3, lines 33 – 64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

18. As per claim 17, Campbell teaches a system for use in generating a diagnosis report, comprising:

- A processor (figure 1, #120, #121);
- Observation term selection result obtaining means for obtaining a selection result from a plurality of observation terms about an observation term corresponding to observation on an examination result (figure 5);
- Supplementary information result obtaining means for obtaining the selection result of supplementary information corresponding to the observation from plural pieces of supplementary information associated with the observation term relating to the selection result (figure 6);
- Observation text generation means for generating observation text representing the observation term relating to the selection result obtained by the observation term

selection result obtaining means and the supplementary information relating to the selection result obtained by the supplementary information result obtaining means (figure 6 and column 15, lines 5 - 52);

- Observation information storage means for storing observation information (column 3, lines 34 – 63) which is formed by the observation term relating to the selection result obtained by the observation term selection result obtaining means and the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit, and indicates the observation (Column 8, lines 1 – 26 as an example); and

Campbell does not explicitly teach the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term selection result obtaining means (column 13, line 66 through column 14, line 8 or column 18, line 61 though column 19, line 7 for various drop down boxes with lists).

However, Oon teaches the system comprising:

- Wherein the observation text generation unit arranges a word and phrase that have been, in advance, associated with the supplementary information relating to the selection result obtained by the supplementary information result obtaining unit before and after the observation term relating to the selection result obtained by the observation term

selection result obtaining means (column 32, line 59 through column 33, line 39 where concatenation is the process of combining text).

Where the observation text generation means, the observation display means, the treatment information obtaining means, the storage means are all a computer, with display and databases (column 3, lines 33 – 64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature to Campbell. One of ordinary skill in the art at the time of the invention would have added this feature to Campbell

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately.
    - In addition, the Examiner notes other uses of concatenation within the medical/ diagnostic field as described within Bolling et al., U.S. Patent Number 4,967,368, Auer et al., U.S. Pre-Grant Publication 2002/ 0091548 and Soll et al., U.S. Pre-Grant Publication 2003/ 0055679.

Response to Arguments

19. Applicant's arguments, see 35 U.S.C. 112, 1st paragraph rejection, filed 12/26/2008, with respect to claims 1 – 5, 8 – 13, 16 and 17 have been fully considered and are persuasive. The 35 U.S.C. 112, 1st paragraph rejection of 1 – 5, 8 – 13, 16 and 17 has been withdrawn.

20. Applicant's arguments, see 35 U.S.C. 101 rejection, filed 12/26/2008, with respect to claims 1 – 5, 8, 9, 12, 13, 16 and 17 have been fully considered and are persuasive. The arguments, see 35 U.S.C. 101 rejection of claims 1 – 5, 8, 9, 12, 13, 16 and 17 has been withdrawn.

21. Applicant's arguments filed 12/26/2008 have been fully considered but they are not persuasive.

- Regarding the 35 U.S.C. 101 rejection of claims 10 and 11, the pre-amble of the invention is provides the intended use of the invention. Therefore, the added potential structure within the pre-amble does not tie the invention to a particular machine.
- Regarding the 35 U.S.C. 103(a) rejection
    - The Applicant states, "While Oon et al. and Campbell et al. do not disclose or suggest arranging words and phrases associated with the selected supplementary information before and after the observation term relating to the selection result."
        - The Examiner has used and continues to use the Oon reference to describe the idea of concatenation or "to join together tow or more sets of data." (Dictionary of Computing) The Examiner further notes that Oon describes adding prefixes and suffixes onto individual words however a phrase may be "a word or group of words read or spoken as a unit and separated by pauses or other junctions" (American Heritage Dictionary of the English Language).
        - The intended use of the concatenated information has no patentable weight.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./
Examiner, Art Unit 3626
2/9/2009

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626